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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/780,122
Filing Date: February 17, 2004
Appellant(s): FISCHER ET AL.

John W. Carpenter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 24, 2008 appealing from the Office action mailed April 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,921,449	SAEGUSA ET AL	7-1999
5,916,399	OLSEN	6-1999
4,605,461	OGI	8-1996

(9) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claims 10 through 15 and 17 through 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Saegusa et al. (US 5921449) in view of Olsen (US 5916399) and Ogi (US 4605461).

With respect to claims 10, 11, 17, and 18, Saegusa et al. discloses a method to form a spare tire cover to extend over a tire completely (column 1, lines 44-46), which includes molding a vinyl material in the shape of a tire cover comprising a cylindrical panel extending around the tread surface of the tire (column 1, line 15; column 2, lines 60-63) and a face panel with a display surface connected to the cylindrical panel (column 2, lines 63-65; column 3, lines 64-67).

However, Saegusa et al. does not disclose the step of contacting the display surface with a transfer pattern. Olsen teaches a method for forming retroreflective graphic images on a surface (column 1, lines 8-11). The graphic images are formed via contact between a transfer sheet material and a substrate (column 2, lines 14-17). The transfer sheet material contains the following components: a base sheet with a heat-softenable layer (column 3, lines 28-32), a monolayer of glass microspheres attached to a color layer in an imagewise pattern, a reflective layer in a second imagewise pattern, and a bonding layer embedding over all exposed surfaces (column 2, lines 17-36; Figure 1). The glass microspheres are cascaded onto the base sheet and the color layer, comprising polyurethane-based inks, is screen printed onto the microspheres

(column 3, lines 27-32 and lines 43-44; column 4, lines 6-12; column 9, lines 37-41). The bonding layer penetrates the fabric and attaches the design to the fabric; this layer is printed in an imagewise manner over both the color and the reflective layers. The bonding composition is printed in an amount which is at least sufficient to embed all exposed surfaces of the color layer and the reflective layer (column 6, lines 23-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used this transfer pattern to make an image on the sidewall panel of the tire cover. One would have been motivated to do so because the graphic images produced are used for multi-colored emblems or designs and could be potentially used for safety procedures (column 2, lines 8-11).

Saegusa et al. in view of Olsen do not teach removing a base sheet from the pattern as well as removing portions of the color layer attached to a monolayer of microspheres. Ogi teaches a method of transferring a retroreflective pattern from a sheet onto a fabric surface where in removal of a base film (22), portions of a colored transparent film (30) are removed also (abstract; column 2, line 59 – column 3, line 10; Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove portions of the color layer in the transfer sheet as Ogi taught and would have been motivated to do so to vary the colors produced in the final pattern.

With respect to claim 12, Saegusa et al. discloses sewing sheets as the face panel to form the spare tire cover (column 3, lines 21-22).

With respect to claim 13, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches that the second pigmented material in the transfer pattern has retroreflective properties. The graphic segments in the layers, which are both colored and retroreflective, can be illuminated with a light beam which brilliantly retroreflects in the color of the underlying graphic design (column 8, lines 30-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared the second pigmented material in the transfer pattern to have retroreflective properties. One would have been motivated to do so because the color layer filters the light rays as they pass through the colorant of the color layer, and the filter action produces a color hue in these light rays (column 8, lines 35-38).

With respect to claim 14, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches that the second pigmented material in the transfer pattern has does not have retroreflective properties. The layer contains pigment or dye and a transparent resin (column 4,nlines 30-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have prepared the second pigmented material in the transfer pattern to not have retroreflective properties. One would have been motivated to do so because increasing the proportion of colorant tends to deepen the colors produced (column 8, lines 38-40).

With respect to claim 15, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the use of different colored pigmented materials in the transfer pattern. If two differently colored colorant compositions are printed in layers that do not overlap, the layers contribute to a multi-colored design (column 4, lines 22-24). If layers are overlapped, an additive color is achieved (column 4, lines 24-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used different colored pigmented materials in the transfer pattern. One would have been motivated to do so because the graphic designs and images produced are multi-colored or of a unique additive color (column 4, lines 13-15).

With respect to claim 19, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the use of a hot-melt adhesive in the bonding layer of the transfer pattern. The bonding composition has a hot-melt adhesive powder fused into the resin of the layer (column 6, lines 35-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a hot-melt adhesive in the transfer pattern. One would have been motivated to do so because the hot-melt adhesive powder can be applied in any suitable technique known in the art and promotes the bonding of the transfer sheet to the substrate (column 6, lines 60-62; column 7, lines 4-5).

With respect to claim 20, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the application of pressure when contacting the transfer pattern and the display surface. A pressure-

sensitive adhesive could be used as the adhesive in the bonding layer and still retain an imagewise pattern through transfer (column 8, lines 50-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied pressure when contacting the transfer pattern and the display surface. One would have been motivated to do so because applying pressure where the transfer pattern includes a pressure-sensitive adhesive would avoid the use of heating to form the contact between the transfer pattern and display surface (column 8, lines 53-54).

With respect to claim 21, the teachings of Saegusa et al. are as described above. The difference between Saegusa et al. and Olsen is that Olsen teaches the application of heat when contacting the transfer pattern and the display surface. The transfer is accomplished by laying the pattern against the substrate surface and then placing the assembly in a heat-transfer machine set (column 8, lines 7-9). During this time, the bonding layer softens to penetrate into the substrate through openings in the substrate surface (column 8, lines 13-14). The assembly is then permitted to cool so that the bonding layer exhibits a strong adhesion to bond the transferred emblem to the substrate (column 8, lines 15-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used heat when contacting the transfer pattern and the display surface. One would have been motivated to do so because using heat creates a strong adhesive bond between non-woven materials (column 8, lines 3-6).

(10) Response to Argument

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to the argument that neither Olsen nor Ogi does not teach the step of removing a substrate to remove a first pigmented layer as well, it is agreed that Olsen does not teach transfer printing a retroreflective pattern by removing a base sheet (16) as well as removing portions of the color layer (22) attached to a monolayer of microspheres (12) (Figure 2). However, Ogi teaches a method of transferring a retroreflective pattern from a sheet (20) onto a fabric surface (10) where in removal of a base film (22), portions of a colored film (30) are removed also. As seen in Figure 2 of Ogi, colors of a transferred image will vary, where the transferred image has visible portions of a colored film (30), metal film (32), and exposed surfaces of microspheres (26).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With respect to the argument that Olsen does not provide motivation to transfer print graphic images to a sidewall of a tire cover, Saegusa et al. teach that a soft fabric cover for a tire is printed upon with a logotype (column 1, lines 12-15; column 3, lines 64-67). Olsen teaches transfer printing an image to a fabric surface because fabric substrates with transferred graphic images can exhibit good wash durability and good dry-cleaning durability. Furthermore, Olsen teaches applying a retroreflective image could be used for safety procedures (column 2, lines 8-11; column 3, lines 6-9). Also, although no specific mention is made by Olsen to apply an image to a tire cover, both Saegusa et al. and Olsen teach applying images to fabric surfaces.

With respect to the argument that Olsen does not teach a second pigmented material with limitations of claim 13, Olsen teaches providing a second, reflective pigmented layer (26), comprising reflective ellipsoidal flakes such as nacreous or pearlescent pigment particles (column 5, lines 47-51; column 5, line 66 – column 6, line

1). Thus, Olsen's teaching is broad enough to conclude that it would have been obvious to provide a second pigmented layer with reflective particles to provide a portion of the sheet material which is capable of retroreflecting color in the overlying first pigmented layer (22) when microspheres are illuminated with a beam of light (column 5, lines 21-27).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sonya Mazumdar/

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